Certain Phases of Reissues

Particularly

Delay in Filing the Application, and Inadvertence, Accident or Mistake

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BY

L. D. UNDERWOOD,
Principal Examiner, Division Seven,
U. S. Patent Office.

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BRIEF OF POINTS.

The first reissue statute was passed in 1832.

Prior to that time, reissues were granted, and they were upheld by the Supreme Court in Grant *vs.* Raymond.

Up to about 1882, the practice was extremely liberal, allowing a reissue of a patent practically at any time during its life, for anything which might have been claimed in the original, and sometimes even for more than was disclosed.

This resulted in great hardships to manufacturers.

To correct these evils the Supreme Court, in the case of Miller *vs.* Brass Co. (decided in 1882), laid down the doctrine of laches.

This doctrine was founded upon the theory that the statute did not in terms, provide for enlarged reissues. A change in the rules immediately followed requiring the applicant to file an oath setting forth what the errors were which constituted the inadvertence, accident, or mistake, and how they arose or occurred.

Where the claims are restricted delay may be disregarded, unless the delay occurred after the defect was discovered.

"Inadvertence, accident, or mistake," is used in antithesis to fraudulent intent, and comprehends every error by which the patent fails to give the protection which it should have given.

Claims may be broadened by reissue filed within two years, where there has been a clear error, which may consist merely of want of knowledge or attention, experience, or capacity on the part of the solicitor or the applicant.

After two years each case must be governed by its special facts and circumstances.

Certain Phases of Reissues, Particularly Delay in Filing the Application, and Inadvertence, Accident, or Mistake.

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Principal Examiner, Division 7,
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REISSUES BEFORE THE FIRST REISSUE STATUTE.

In the foundation of our Government it was deemed conducive to the progress of its people that a monopoly for a limited time be granted to the inventors or discoverers of new and useful inventions. In conformity with the Constitutional provision the first patent statute was enacted in 1790 authorizing the Secretary of State, or the Secretary of War, or the Attorney-General, to cause letters patent to be made out in the name of the United States, it being required that such letters patent be attested by the President of the United States, and certified by the Attorney-General upon his finding that the grant had been made in conformity with the act.

It was obviously the purpose of the law to protect inventors for the actual invention disclosed, for clearly it would be a miscarriage of justice should the public be given the benefit of the inventor's disclosure without at the same time securing to him a monopoly of the invention for the period set out in the statute, which originally was fourteen years. But it sometimes happened that a patent, while disclosing the invention fully to the public, failed for some reason to protect the inventor in his exclusive rights. It was then a serious question how the rights of the inventor could be secured as there was at first no authority given in the statute to amend or correct an imperfect patent. Notwithstanding the failure of the statute to give any express authority in this regard patents were frequently reissued

with a view to giving to the inventor the protection which it was intended that the original patent should give. Reissues were at first granted by the Secretary of State. The right to reissue came before the Supreme Court for the first time in January, 1832, and the power to grant reissues was considered. The objection was raised that the Secretary of State was merely a ministerial officer and could exercise no power not expressly given. On this point, the court, speaking through Chief Justice Marshall, said:

> It is undoubtedly true, that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the act of Congress contains no words which expressly authorize the secretary to issue a corrected patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it is felt. If the new patent can be sustained, it must be on the general spirit and object of the law, not on its letter.

The opinion then points out that a law for the protection of inventors was one of the first passed by Congress, and that it was the purpose of that law to confer on them an exclusive right to their inventions for a definite period as a compensation for their exertions and the disclosure of the invention to the public. The law should be construed, the court said, so as—

> to execute the contract fairly on the part of the United States, where the full benefit has been actually received, if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives *all* which it has contracted to receive. The *full*

> benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it during that time, the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.
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> If the mistake should be committed in the department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the eror, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has been innocently committed by the inventor himself? Grant *vs.* Raymond, 6 Peters, 218-240.

The decision held the reissue valid notwithstanding the absence of statutory authority to grant it.

STATUTORY PROVISIONS.

This decision was rendered in January, 1832. On July 3, 1832, the first resissue statute was enacted which provided "that whenever any patent which has been heretofore, or shall be hereafter, granted . . . shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section" of the act of 1793 "have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intentions been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired." This act also gave the right of reissue to his assignees. In the law of 1836,

the provision for reissues is found in section 13, which provided that reissues should be granted whenever a patent was inoperative or invalid "by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention, more than he had a right to claim as new, if the error has, or shall have arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention." The portion of the act of 1836 quoted is in substantially the same words as section 4916, Rev. St.—the present reissue statute.

Although the statute as it stands today is essentially the same as the statute of 1836, the practice was considerably modified from time to time, changes being brought about by judicial interpretation. Let us look at the development of the practice and the reasons therefor.

PRACTICE UNDER THE STATUTE CHARACTERIZED BY GREAT LIBERALITY—CAUSES AND RESULTS.

Reissues were always granted for the purpose of securing to the inventor the real invention which he sought originally to protect, when the original patent failed to give adequate protection through some inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the early practice all that was necessary to establish inoperativeness or invalidity, and inadvertence, accident, or mistake, and absence of fraudulent intent was the affidavit of the inventor or assignee to that general effect. It was not necessary to make any statement, under oath or otherwise, showing in what respect the original patent was defective, what the errors were, or how they arose or occurred. The first provision in the rules requiring the applicant for reissue to specify the defects in the original patent and the errors which occasioned them occurs in Rule 46 of the Rules of September 1, 1863, which provided that "all applications for reissue must be accompanied by a statement clearly setting forth in what respect the original specification is inoperative or invalid,

and what inadvertency, accident, or mistake occurred, that the office may have the means of determining whether it was without any fraudulent intent." This was omitted in the next edition of the Rules of January 1, 1865, and a similar provision was not made until 1882.

The demand for the restriction of reissue was widespread but the remedy was not obvious. In 1876, a prominent attorney of Philadelphia—Mr. Howson—suggested that every applicant for reissue be required to "file a paper setting forth in full and explicit terms wherein consists the error, inadvertence, or mistake contained in the oiginal patent which he desires to correct by reissue. If language is introduced which does not appear in the original patent, he must state why he introduced it, and whether it is based on the model, drawing, or specification. If new functions, which do not appear to have been contemplated in the original patent, are given in the new specification, a full explanation will be demanded from the applicant, tending to show the accuracies of the new assertions, and when expanded claims are asked, he must state the ground on which they are based." This suggestion however was not adopted.

Rule 86 of the Rules published September 1, 1880, provided that "the affidavit of the applicant will be prima facie evidence as to inadvertency, accident, mistake, fraud, and deceptive intent, subject to contradiction or confirmation by the records of the office, by the affidavit of employees of the office having personal knowledge of the facts, or by such other affidavits as the Commissioner shall, without disclosing the pendency of the application, admit as evidence in the case."

In the next edition of the Rules published April 15, 1882, a decided step was taken toward restricting reissues by requiring that the applicant set forth particularly the defects or insufficiencies in the specification which rendered the patent inoperative or invalid, that he explain how the errors arose in order that the question of inadvertence, accident, or mistake might be determined, and make oath that such errors arose without fraudulent intent. It was afterward required (Rules of

Practice, November 16, 1885), that all these allegations be made under oath. The practice in this respect is now covered by Rule 87 which was recently held valid by the Court of Appeals of the District of Columbia, in Fullagar, 192 O. G., 1263; 40 App. D. C., 510. The purpose of requiring a statement of the particular errors and how they arose or occurred was evidently to bring out on the record all the facts in order that the office could judge whether the alleged mistake was a *bona fide* mistake, or a deliberate act inconsistent with applicant's allegation. This requirement has an analogy in the requirement of Rule 75, that an affidavit filed thereunder shall state "facts" as distinguished from the conclusion of the affiant. In both cases, the purpose is to substitute the judgment of the officers who are charged with the duty to administer the law for the conclusion of another. Since 1885, the practice on this point has not materially changed.

From the facts stated it is apparent that the early requirements as to the showing of defects in the original claims and the mistakes which caused them were so easily complied with that, until 1882, they offered practically no obstacle to the reissue of any patent with either restricted or broadened claims.

Another matter which caused some difficulty in the development of the law involved the relation between the inventions covered by the original and reissued patents. It was always the purpose to restrict the invention covered by the reissue to the invention which the original patent was intended to protect. But views varied as to the right of the inventor to amend his specification, drawings, and model, or to add to the disclosure in the reissue application matter which the inventor intended to include in the original description, drawings, or model, but which he failed to include through some inadvertence. It was the established practice for many years to permit the inventor to include in the reissue anything which he might have included in the original. Hence he could amend the description by the drawings or the model, or the model and drawings each by the other, but he could not amend the model and drawings by the description except in a clear case, the description being considered as uncertain.

Rule 54, of the Rules of February 20, 1854, stated that "the general rule is, that whatever is really embraced in the original invention, and so described or shown that it might have been included in the original may be claimed in a reissue, but in case of machine, model and drawings must be amended each by the other; but when there is neither model nor drawings amendments may be made upon proof satisfactory to the Commissioner that such new matter was a part of the original invention and was omitted through inadvertence. The Rules of Practice of July 15, 1870, provided that "anything which might have been included in the original may be claimed in a reissue."

For a time prior to this it was the practice to permit the inclusion in a reissue of inventions not disclosed in the specification, drawings, or model on sufficient proof that such invention was a part of the original invention. This practice resulted from an extremely liberal interpretation of the statute to the effect that the inadvertence, accident, or mistake referred to inadvertence in a failure to disclose the invention rather than a failure to point out the invention so as to distinguish the old from what was claimed as new. It was soon decided however that this was illegal (Carhart *vs.* Austin, 2 Fisher, 543; Goodyear *vs.* Providence Rubber Co., 2 Fisher, 499; Sickles *vs.* Falls Co., 2 Fisher, 202), and that the reissue must be restricted to matter disclosed in the original patent. This dangerous tendency to claim even more than was disclosed in the original was definitely checked by the provision of Section 53 of the act of 1870, which provided that "no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other." It is to be noted however, that the present reissue statute still permits the insertion of matter not originally included in cases where there is no drawings or model, upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention and was omitted from the specification by inadvertence, accident, or mistake."

Another reason for the early liberal practice on the granting of reissues was the fact that the doctrine of laches in the filing of the application had not yet been

evolved. No statute that has ever been passed relating to reissues has made diligence a condition precedent to the grant. The statute gave the right of reissue to one who had inadvertently failed to secure the protection to which he was entitled. It was assumed that it was the intention to secure to the inventor what he should have secured in taking out the original patent even though a correction of the error long after the publication of the patent, and the public use of the invention, might work some hardship on the public. Therefore it appears that the length of time intervening between the grant of the original patent and the filing of the reissue application was not considered. Reissues broadening a patent were granted but a short time before its expiration. An instance of the length to which the practice went is found in the decision of the Supreme Court in the case of Gage *vs.* Herring, 22 O. G., 2119; 107 U. S., 640, involving reissue patent, 4712. The original patent, if its term had not been extended, would have expired on April 20, 1872. In December, 1871, four months before the time of expiration, a reissue was applied for (this being the second reissue), adding a claim to the single prior claim, which broadened the scope of the patent by omitting from the new claim two of the seven elements before claimed. The oath simply averred that the petitioner "verily believes that, by reason of an insufficient and defective specification, his aforesaid letters patent (the first reissue) are inoperative or invalid; that the said error (no error was stated) had arisen from inadvertence, accident, or mistake, and without any fraudulent intention, to the best of his knowledge or belief." The reissue was granted in less than a month without objection or comment.

On account of the extreme liberality of the practice upon the identity of the invention, showing of inadvertence, accident, or mistake, and the time within which reissues might be granted, a reissue was resorted to very frequently. In 1863, the number of reissues granted was 6 per cent of the total; in 1870, it was 3½ per cent. Comparing these figures with a percentage of .24 for 1895, it is found that the percentage of reissues of 1863 bear to the reissues of 1895, the proportion of 25 to 1. Furthermore, the patents reissued

were those of most importance in the arts and industries. The evils resulting from this liberal policy were observed and commented upon, although it is due to the Patent Office to say that its policy was directed by the law and the decisions of the courts, and it could not materially restrict the right of reissue as it had always been recognized without assuming an arbitrary power.

On this point a prominent patent attorney in 1882 said:

> Although the Patent Office may, in some instances, be directly responsible for the grant of outrageous reissued patents, it would be unjust to charge that bureau with the evils resulting from the prevailing latitude in acting on this class of cases, and the permission given patentees to absorb by reissue, the inventions of others.
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> Many expanded reissued patents of doubtful character have been sustained by the courts, while many others have been slaughtered.
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> The treatment of reissued and expanded patents by the courts has not been uniform, and in the light of apparently conflicting judicial opinions, the office has been unable to draw a well-defined line for the guidance of Examiners in their consideration of reissue applications.
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> The understanding and opinions of Examiners naturally enough differed on the subject, and the consequence of all this has been the long continuance of a system of so-called liberality in the grant of reissued patents with enlarged claims.

The Supreme Court graudually developed a strong antagonism to enlarged reissued patents.

In 1879, in the case of Leggett *vs.* Avery, 17 O. G., 445; 101 U. S., 256, commenting on a patent granted on October 9, 1860, surrendered and reissued on June 22, 1869, extended for seven years from October 9, 1874, and again reissued on November 10, 1874, it said:

> The pretense that the error had arisen by inadvertence, accident, or mistake, within the meaning of the patent law, was too bald for human credence. . . .
>
> The allowance of claims once formally abandoned by the applicant in order to get his patent

> through is the occasion of immense frauds against the public. It not unfrequently happens that after an application has been carefully examined and compared with previous inventions, and after the claims which such an examination renders admissible have been settled with the acquiescence of the applicant, he, or his assignee, when the investigation is forgotten and perhaps new officers have been appointed, comes back to the Patent Office, and under the pretense of inadvertence and mistake in the first specification gets inserted into a reissued patent all that had been previously rejected. In this manner, without an appeal, he gets the first decision of the office reversed, steals a march on the public, and on those who before opposed his pretensions (if, indeed, the latter have not been silenced by purchase), and procures a valuable monopoly to which he has not the slightest title.

General Leggett made the following comment:

> "In these reissues more deviltry—if I may be permitted to use the phrase—creeps into the practice of patent law, than everything else put together."

EVILS AND REMEDIES THEREFOR.

What were these evils which gave so much concern to the Patent Office and the courts?

Generally stated it was the withdrawal of rights which mechanics and manufacturers had exercised for years, not in favor of the real inventor or the one who had done most to advance the sciences and useful arts, but in favor of a mere speculator who had never done anything but conceive of a way in which an apparently worthless patent might be expanded into one of far-reaching importance. The practice which prevailed is quite fully set forth in a pamphlet written by Mr. H. Howson, of Philadelphia, published in 1877, when discussions relat-

ing to proposed patent legislation took place before the Senate Committee on Patents. He said:

> "A patent, or series of patents, relating to some special branch of industry, has been obtained, and capital has been invested in the manufacture of the patented articles. Now in these days, the simplest objects of every-day use can not be economically manufactured without an outlay for machinery and appliances, and for carrying into effect a proper system of division of labor; the public demands not only new things but better things and cheaper things, and this demand can only be supplied by patents, and by the capital which patents invite. The remarkably cheap products of our workshops at the Centennial Exhibition were matters of surprise and astonishment to our visitors from abroad, where labor is much less expensive than in our own country.
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> "The factory, based on patents, is in full and successful operation, the proprietor is receiving a fair interest for the capital invested, and the public has the benefit of cheaper and better articles in return for the protection afforded by the Government in the shape of patents.
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> "The success of the establishment can not remain a secret, and it attracts the attention of a patent speculator, whose first move is to try to get hold of some patent preceding those which are owned by the proprietors of the establishment. Failing in discovering a patent to exactly meet the case, he takes an excursion to Washington, probably takes the advice of a solicitor there, to whom he explains what he wants, and together they go on a hunting expedition through the records and model halls, until they find some model of a patent which they think can be doctored by reissue to resemble a subsequent prominent patent of the manufacturer. The model has, perhaps, long since been almost forgotten by the inventor himself, and has remained on the shelves of the model room without attracting any notice. By cunning manoeuvres,

the patent to which the model appertains is purchased from the owner, perhaps for a mere song, and then commences the operation of reissuing; the attorney has the copy of the recently discovered patent before him, and also a copy of that for the coveted machine of the successful manufacturer, and he is told that he must reissue the first patent so as to cover, or, to use a common phrase, wipe out the second.

"The most ingenious devices are adopted to bring this about,—the attorney receives high fees, and the Examiner is cajoled by all sorts of assertions into allowing claims which may appear to be innocent enough.

"The reissued patent is shown to the manufacturer, and he may be induced to purchase it for a large sume in order to avoid expensive litigation. Now this money is taken from the public to enrich the speculator, the non-producer, for, to make up for the withdrawal of capital, the price of the product is increased. Perhaps the manufacturer resists the demand made on him, costly litigation ensues, and the public and manufacturer suffer for the benefit of the owner of the reissued patent.

"The evil wrought by this system is incalculable; it not only disturbs the economy of manufacture, but brings disgrace on the whole patent system. A reissue of this character can not promote the progress of the useful arts, it must necessarily obstruct that progress."

There are scores of instances in which patents were issued, reissued, and re-reissued to keep pace with "the progress of the arts as developed by time and experience." In one instance, a patent was granted with a single, modest, and harmless claim; in the branch of industry to which it related, several valuable improvements were made, the patent was reissued to absorb these improvements, again reissued to cover other improvements, and again reissued, until at last, the little patent with a specification of 450 words and a single claim was

converted into two patents with 8,000 words and seventeen claims.

Remedies to correct these evils were suggested and attempted from time to time. Fomerly the owner of the entire interest in a patent could reissue it without the knowledge or assent of the inventor; but since the act of 1870, the inventor if alive, must make the application. This remedy however, had little effect as it was generally an easy matter, by misrepresentation or through the intervention of emissaries, to obtain the signature of the inventor, who was kept in the dark as to the scope and object of the reissue.

In his report of 1871, Commissioner Legget suggested that the law should be so amended as to require that a notice of all applications seeking enlarged claims be published in the Official Gazette, for at least four weeks previous to the day set for examining the same, and that opposition be allowed as in extension cases. It was also suggested that there should be no reissue of a patent after it had been in existence for more than two years.

THE DOCTRINE OF DELAY OR LACHES.

Without any change in the law, however, the Supreme Court found a remedy in the doctrine of laches in filing the application. This doctrine was laid down in the case of Miller *vs.* The Bridgeport Brass Co., reported in 104 U. S., 350; 21 O. G., 201. The decision is dated January 9, 1882. The facts in that case are briefly set forth in the decision as follows:

> "The original patent described a combination of devices, amongst other things, *two* domes or reflectors, one above the other, elevated above a perforated cap through which a wick tube and vapor tube ascended.
>
> "It was claimed that this combination of devices, especially including the two domes, which admitted the external air between them for producing a more perfect combustion, would make a lamp, which, *without a chimney*, and without danger of explosion, would burn those hydrocarbons which are volatile and contain an excess

of carbon. The invention proved a failure, but it was found that *the use of one of the domes* (and the other parts) *with the restoration of the chimney,* would be a real improvement, and both plaintiff *and defendant* made such lamps in large quantities. *Fifteen years after the original patent was granted,* the patentee (or rather his assignee) discovers that the improved lamp was really a part of his original invention, and that by inadvertence and mistake he had omitted to claim it.

"Upon this state of facts, the court said: 'We think, that the court below was clearly right in holding that the invention specified in the second claim of the reissued patent (the one in question) is *not* the same invention described and *claimed* in the original patent.' "

The court might have rested its decision on their conclusion that the reissued patent was not for the same invention as the original. Or they might have rested the decision on the finding of no inadvertency, accident, or mistake, for the opinion says:

"But there is another grave objection to the validity of the reissued patent in this case. It is manifest on the face of the patent when compared with the original, that the suggestion of inadvertence and mistake was a mere pretense."

But the court proceeds to say:

"Or if not a pretense, *the mistake was so obvious as to be instantly discoverable* on opening the letters patent, *and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the claim was not as broad as it might have been.* THIS MISTAKE, IF IT WAS A MISTAKE, WAS APPARENT UPON THE FIRST INSPECTION OF THE PATENT, AND IF ANY CORRECTION WAS DESIRED, IT SHOULD HAVE BEEN APPLIED FOR IMMEDIATELY.

"These *afterthoughts, developed by the subsequent course of improvement,* and intended, by an ex-

pansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion.

"If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, *uses due diligence in returning to the Patent Office,* and says, 'I omitted this,' or 'my solicitor did not understand that,' his application may be entertained, *and on a proper showing,* correction may be made.

"But it must be remembered that the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, ARE IN LAW A DEDICATION TO THE PUBLIC OF THAT WHICH IS NOT CLAIMED.

"*It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public.* This legal effect of the patent can not be revoked unless the patentee surrenders it and *proves* that the specification was framed by real inadvertence, accident, or mistake, without any fraudulent or deceptive intention on his part; *and this should be done with all due diligence and speed.* Any unnecessary laches or delay in a matter thus apparent on the record, affects the right to alter or reissue the patent for such causes. If two years' public enjoyment of an invention with the consent and allowance of the inventor, is evidence of abandonment, and a bar to an application for a patent, *a public disclaimer in the patent itself should be construed equally favorable to the public.* Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, *is admissible where it is sought merely to enlarge the claim.*

"Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake occurred, not from a mere error of judgment (for that may be rectified

by appeal); but a real, *bona fide* mistake inadvertently committed, *such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct.* Reissues for the enlargement of claims should be the exception, and not the rule."

Here the Supreme Court, fifty years after its first consideration of a reissued patent and forty-six years after the enactment of the statute, gave a new force to its terms, and laid down a doctrine never before known to the patent law—that of delay and intervening rights.

FOUNDATION OF DOCTRINE OF LACHES.

The decision of the court in Miller *vs.* Brass Co., was intended to, and did, put a stop to the hardships placed upon manufacturers by the undue enlargement of patents many years after the invention covered thereby had gone into public use. Let us now look at the foundation of the doctrine as enunciated by the court. As shown by the decision itself the court found its authority for the doctrine in the general principles of the law, and in the equitable doctrine that laches may forfeit an existing right. The court reasoned in substance as follows:

That the law of 1832 provided for a reissue where there was a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention. That the law of 1836 enlarged the power to grant reissues by adding an additional ground for reissue, namely, that the patentee had inadvertently claimed more than he had a right to claim; that prior to this time no claim had been required to be made, and therefore that the enlargement of the claim was not in the mind of Congress when the statute was enacted; that the law in terms contemplated only a correction of the description and a restriction of the claim and not an enlargement of a restricted claim. They concluded that if the patentee was entitled to amend his patent when he had claimed too little it was only under the general terms of the law, and on principles of equity, and that in such case, equity would restrict the privilege so as to protect the public from

the evils to which it had been subjected by unwarranted reissues.

Robinson, in his work published eight years after the decision of the court, maintains that the reasoning of the court is founded upon a fundamental error in assuming that the word "specification" in the phrase "defective or insufficient description or specification" did not refer to the claims; that while prior to the law of 1836, no formal claim was required, nevertheless it had been customary to make a "claim" and this part was often referred to as the "specification" of the invention; that the statute therefore did in terms provide for the correction by reissue of an error by which the patentee failed to secure sufficient protection. The learned author contends that the statute might have been interpreted as providing for an enlargement of the claims and that the doctrine of laches might have been founded as well upon the theory that delay is inconsistent with the existence of inadvertence, accident, or mistake.

If we should regard delay merely as evidence bearing on the question of inadvertence, accident, or mistake, it would result probably in a more uniform application of the doctrine of laches; but that the courts have not adopted this viewpoint is believed to be evident from their decisions made since the publication of Robinson's work. If the doctrine of laches were brought within the statutory provisions it is not seen how any distinction could be made between enlarged reissues and those which were restricted or otherwise amended. But the decision of the courts since the decision of Miller *vs.* Brass Co., make a clear distinction between broadened and narrowed reissues as will be shown later. Furthermore, the trend of the decisions bears out the conclusion that the doctrine of laches must be regarded as an equitable doctrine, and that the authority of the courts to hold a reissue invalid on account of delay in filing the application, is founded upon equitable principles and not upon the terms of the reissue statute.

As above pointed out in Miller *vs.* Brass Co., the courts looked upon the failure to claim devices or combinations apparent on the face of the patent as a dedication to the public of that which is not claimed. "It is a declaration that that which is not claimed is either not the patentee's

invention, or, if his, he dedicated it to the public. The legal effect of the patent can not be revoked unless the patentee surrenders it and proves that the specification was framed by real inadvertence, accident, or mistake. . . . Nothing but a clear mistake, or inadvertence, and a speedy application for its correction, is admissible where it is sought merely to enlarge the claim." The nature of the mistake contemplated is referred to as a "*bona fide* mistake, such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct."

In Topliff *vs.* Topliff, 145 U. S., 156, 59 O. G., 1257, decided ten years later, the Supreme Court, after a review of the decisions of the courts since Miller *vs.* Brass Co., stated the rule governing reissues as folllows:

> From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:
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> First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.
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> Second. That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.
>
> Third. That this court will not review the decision of the Commissioner upon the question of inadvertence, accident or mistake, unless the

> error is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all such cases, a question of law for the court.

Here the court reaffirmed the doctrine of Miller *vs.* Brass Co., and treated the failure to claim in the original patent as a constructive abandonment. Furthermore, in the statement that the court would not review the decision of the Commissioner upon the question of inadvertence, accident, or mistake, but that the question of delay, was one of law for the court, is implied the thought that delay can not be considered merely as evidence bearing upon inadvertence, accident, or mistake.

CONFLICT OF DECISIONS.

The questions of identity of invention, inadvertence, accident, or mistake, delay and intervening rights, have been so confused by the courts that the correct principles which shall govern the practice of the Patent Office in the granting of reissues are very difficult to determine. On these points, one may find a decision of some court to sustain almost any position which one might wish to assume. Some of the courts drew from Miller *vs.* Brass Co., the conclusion that a reissue could not enlarge the original claim; that this was wrong is indicated by the later decision in Topliff *vs.* Topliff. There is much conflict and uncertainty in the decisions upon each of these several matters.

If some of the controverted points can be settled to our satisfaction, it will aid materially in a ready disposition of the rights of reissue applicants.

RESTRICTED REISSUE—DELAY OF LITTLE CONSEQUENCE.

It seems to be fairly well settled by the best considered decisions of the courts that where it is sought merely to restrict the original patent, which is found to be too broad, delay is not of importance. The distinction between enlarged and narrowed reissues was made in the

case of Miller *vs.* Brass Co., and reiterated in Topliff *vs.* Topliff. In the enunciation of the doctrine of laches, the court indicated that where it was sought to enlarge the claims greater diligence would be required than where it was sought merely to correct the description or restrict the claims. There seems to be no conflict of authority upon this point but no court has laid down any general rule. In Sirocco Engineering Co. *vs.* B. F. Sturtevant Co., 173 Fed. Rep., 378, a reissue restricting the claims was held valid although the application was filed seven years after the granting of the original patent. In Steiner & Voegtly Hardware Co. *vs.* Tabor Sash Co., 178, Fed. Rep., 831, a delay of twelve years was held not a bar where the patent was narrowed. The latest decision on this point is in the case of Motion Picture Patents Co. *vs.* Laemmle, 214 Fed. Rep., 787, in which the Edison reissue patent for motion picture machines, granted over fourteen years after the date of the original patent, was held valid. In this case, the court set forth the distinction between broadened and narrowed reissues in the following words:

> "The books are full of cases where the courts have appreciated the importance of intervening rights, and have realized the injury which may or will be done to the public where, after either an unreasonable delay or a process of experimentation with court decisions, an attempt is made to broaden claims. In such instances, industry and commercial progress may be arrested if the courts were to hold to any doctrine which made it dangerous for energetic men to enter upon some well-defined field of activity only to discover subsequently that a grant theretofore given had been enlarged beyond the limits so defined. Thus it is that there is a line of cases of which Miller *vs.* Brass Co., 104 U. S., 350, 26 L. Ed., 783, and Thomson-Houston Electric Co. *vs.* Western Electric Co., 158 Fed., 813, 86 C. C. A., 73, are examples. Nowhere, however, has it been held that a reissue wherein the claims are narrowed is void for laches. It is true that in Pelzer *vs.* Meyberg, 97 Fed., 969, it was held that there were

degrees of diligence in applying for a reissue, and that a higher degree was required in the case of a broadened claim than in the case of a narrowed claim. The case came up on demurrer, and apparently there was no excuse for the delay set forth."

It is to be noted that in this case the reissue gave the patentee a distinct advantage over and above that which flows from the conversion of a claim invalid because too broad, into a restricted valid claim. It secured to him a valid patent on which he might maintain suit for infringement, whereas it was a matter of much doubt whether suit could be maintained at all on the prior patent by reason of the patentee's failure seasonably to file, under Section 4922 R. S., a disclaimer of a claim which had been held invalid by the Circuit Court of Appeals. It is to be noted also that the patentee had delayed the filing of the reissue for over three years after the Court of Appeals had held the claim invalid, thus being clearly put upon notice of the defect by the ruling of a court whose decision is final on patent questions.

From a review of the authorities on this point it seems fair to conclude that when it is sought to restrict a patent, delay is of no consequence. This should be true even where it is proposed to secure more restricted claims in addition to the broader claims of the original patent; in other words, the rule should be regarded as permitting the addition of claims at any time during the life of the patent which come within the scope of the original claims, providing, of course, a proper showing is made of inadvertence, accident or mistake, and providing due diligence was exercised after the discovery of the error.

INTERVENING RIGHTS.

Intervening rights, which has been fatal to so many reissues, is a question which does not often, if ever, come before the Patent Office. The prosecution of reissue applications is entirely *ex parte,* as in other cases, and the office has no way of investigating this matter. There is a question whether the granting of patents between

the date of the original and the reissue is an intervening right. The Circuit Court in Minnesota in the case of American Bank Protection Co. *vs.* Electrical Protection Co., 181 Fed. Rep., 350, decided that it was not. To the same effect is Gaskill *vs.* Myers, 81 O. G., 1111; 1897, C.D., 699. The contrary holding was made by the District Court of New York in the case of Specialty Machine Co. *vs.* Ashcroft Mfg. Co., 205 Fed. Rep., 760, where there had been a delay of three years. This point has but seldom been directly involved and it can not be said that the law in respect thereto is settled. See also White *vs.* Dunbar, 119 U. S., 51; 1886, C. D., 494; American Soda Fountain Co. *vs.* Sweitusch, 85 Fed. Rep., 968; Clements *vs.* Odorless Apparatus Co., 109 U. S., 641; Flower *vs.* City of Detroit, 22 Fed. Rep., 292; Horn & Brannen Mfg. Co. *vs.* Pelzer, 91 Fed. Rep., 665.

INADVERTENCE, ACCIDENT OR MISTAKE—BROADENED AND RESTRICTED REISSUES.

Some of the decisions appear to make a distinction between the character of mistake which would warrant a broadening of claims by reissue and those where other defects are sought to be corrected. This is intimated in Miller *vs.* Brass Co., where the court says that a claim may be enlarged by reissue only when there has been a "real *bona fide* mistake, inadvertently committed, such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct." Since the decision of the court was founded upon the proposition that the statute did not specifically provide for the enlargement of claims by reissue, it might well have imposed the condition that in such cases only such errors as a Court of Chancery might correct would be considered as sufficient ground for reissue, while errors of lesser moment might be corrected where it was sought merely to limit the claims or correct the description. But a review of later authorities indicates that an inadvertence, accident or mistake, which will support a narrowed reissue will also support a broadened reissue. Let us now examine the question, what may be considered an inadvertence, accident, or mistake.

It is believed that the weight of authority will sustain the proposition that any failure to secure in the original patent the invention to which the applicant was entitled which was not the result of a deliberate act, or was not the result of an intention to deceive, may be attributed to inadvertence, accident, or mistake. One of the most thoroughly considered cases on reissue is that of Crown, Cork & Seal Co. *vs.* Aluminum Stopper Co., 1901, C. D., 450, 108 Fed. Rep., 845, decided by the Circuit Court of Appeals for the Fourth Circuit. In that case, the court said:

> "A review of the earlier decision of the Supreme Court would seem to show that by 'defective or insufficient specifications" was meant any failure to describe or claim the complete invention upon which the application for the patent was founded, and that 'inadvertence, accident, or mistake' was used in antithesis to fraudulent intent, and that the right to reissue depends upon any failure to make the specification and claims legally adequate for their purpose, if due to any cause except an intention to deceive."

In the case of In re Briede, 1906, C. D., 677, the Court of Appeals found the existence of inadvertence, accident or mistake, where the error alleged was a failure to secure a certain claim arising from unfamiliarity of applicant and his solicitor with the English language.

In In re Heroult, 1907, C. D., 521, the same court found the existence of inadvertence, accident or mistake, where there was failure to secure a claim of sufficient scope which arose (according to the allegations of applicant, who was a citizen of France) because of ignorance of the difference between the laws of France and the United States.

In the case of Crown Cork & Seal Co. *vs.* Aluminum Stoppér Co., cited above, there was a broadened claim and no showing of any particular inadvertence, accident, or mistake except an allegation that the application papers were hurriedly prepared, and that neither applicant nor his attorneys noticed the defects throughout the years of the prosecution of the application.

In the case of Houghton *vs.* Whitin Machine Works, 153 Fed. Rep., 740, it was held by the Circuit Court of Appeals for the First Circuit, that the failure to make claims of sufficient scope may be regarded as inadvertence, accident, or mistake. In Moneyweight Scale Co. *vs.* Toledo Computing Scale Co., 187 Fed. Rep., 826, 170, O. G., 728, the Circuit Court for the Seventh Circuit said:

> "The original specification alone on its face was sufficient proof that, if a claim adequate to cover the improved scale was never drawn, the failure came from the lack of an attentive comparison of the submitted claims with the invention particularly pointed out in the specification. This was inadvertence, "lack of heedfulness or attentiveness,' irrespective of the real competence or incompetence of the solicitors."

In Topliff *vs.* Topliff, where the Supreme Court sustained a broadened reissue, there was no showing of inadvertence, accident, or mistake, the oath alleging merely that the patent was defective and insufficient, and that the defects and insufficiencies arose from inadvertence, accident, or mistake. It is to be noted however, that the application in this case was applied for before an applicant was required to set forth the particular defects of his patent, what the errors were, and how they arose or occurred.

From a review of the authorities it is believed to be a fair conclusion that a mere failure to claim what was indicated in the drawings and specifications as a part of the invention is an inadvertence, accident or mistake within the meaning of the statute, unless the failure was due to an intent to deceive, or to some deliberate act inconsistent with the theory of inadvertence. And it is believed that this rule is as applicable to broadened reissues where the application is filed within two years of the date of the original patent as it is to restricted reissues. As a general rule, the defects and insufficiencies of a patent are not the result of a failure fully to describe the invention, or a failure to claim it with sufficient particularity; but they result from a failure to make

claims of sufficient breadth to protect the real invention. For example, a claim is made to a combination of four elements whereas it is clear to one skilled in the art that one of those elements may be omitted without destroying the capacity of the device to perform the substantial function set out in the specification. An ordinary inventor, or even one who has had considerable experience in patent matters, could not be expected to know that his invention was not fully covered by the claim to four elements. It must be the common observation of any one who has had any intimate knowledge of these matters that it is difficult even for those who are most highly skilled in the interpretation of claims sometimes to determine the true scope of a claim once drawn, or to draw claims adequate to protect the real invention. These difficulties were forcefully pointed out in the case of Crown Cork & Seal Co. *vs.* Aluminum Stopper Co., *supra,* where the Circuit Court of Appeals said:

> The learned counsel for defendant assumes that the subject is so simple that Painter should have discovered instantly upon reading the original patent the occasion for the reissue, if it existed. He forgets that what seems so simple and easy to him, a past-master of the subject, was not so to a mere inventor, unskilled in the art of interpretation, who could not upon a mere reading of his patent determine what his claims covered. Painter had no hesitation and no doubt what his invention covered, and almost immediately upon the hearing of the issue of Hall's patent he said that it was covered by his invention; but it was not until he was advised by his lawyer that he learned that his claims were not commensurate with his invention, and there was no delay then in filing his application for reissue. Some allowance may well be made for an unlearned man, when we remember that in the recent case of *Westinghouse* vs. *Power-Brake Co.* (C. D., 1898, 443; 83 O. G., 1067; 170 U. S., 537; 18 Sup. Ct., 707; 42 L. Ed., 1136) the Supreme Court itself required three hearings before it could determine the meaning and scope of the patent claims, and the record

in this case shows that such learned experts as General Spear and Mr. Walker differ radically as to what the claims of the original patent cover.

In view of the difficulties of drawing up this very technical document and determining its metes and bounds, it is thought that it should be the general rule to regard any failure to secure to the owner of the patent adequate protection for the invention described and claimed as inadvertence, accident or mistake, if application is made for reissue promptly upon the discovery of the error, and within two years from the date of the original patent, unless the record itself is inconsistent with the allegation of inadvertence, accident, or mistake. In reviewing the showing of inadvertence, accident, or mistake, of course it is always necessary to examine the record of the original patent to see whether there is anything there inconsistent with the allegations of applicant's oath. If one in the prosecution of an application should make a certain claim, and, upon its rejection on references, cancel it in order to receive his patent, it is obvious that his act is deliberate and he will not be heard to say that he was mistaken in his judgment as to the pertinency of the references and desires a reissue to correct the error; the error in such case, if there was error, was not an error within the meaning of the statute, but an error of judgment merely. The same would be true if a disclaimer were entered in the specification during the prosecution of the case. If the record of the original patent is not consistent with the claim of inadvertence the intention of the applicant must be determined from the original record.

DELAY LESS THAN TWO YEARS.

The most difficult of all points to decide in passing upon reissue applications is whether the application has been seasonably filed. This does not present much difficulty when the aplication is filed within two years. By this I do not mean that any application filed within two years is seasonably presented. Reissues have been held void because of laches in filing the application in cases where

the delay was only a few months. An examination of those cases where a delay of less than two years was held fatal will show that in a majority of the cases there were actual intervening rights, or that the owner of the patent did not proceed with diligence after the discovery of the defects in his patent or after he was put upon notice of such defects.

DELAY MORE THAN TWO YEARS.

What are the principles to govern the grant of a reissue application for broadened claims which has been filed more than two years after the date of the patent? No general rules can be laid down. The decision in each case must depend upon the particular circumstances.

In the case of Mahn *vs.* Harwood, 112 U. S., 354, the Supreme Court said:

> "In Miller *vs.* Brass Co., by analogy to the law of public use, before an application for a patent, we suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case."

It should appear from applicant's showing when the mistake was discovered, and if the reissue application was not promptly filed, the reason why. If circumstances were of a compelling nature delay should be excused, but delay on account of attention to other business matters should not suffice as an excuse.

It is not seen that the character of the mistake which it is sought to correct has any relation to the doctrine of delay except as it has a bearing upon its probable discovery. A mistake might be so plain that any interested party, upon reading the patent, would discover it. On the other hand it might be so obscure that one could

not be reasonably expected to discover it. In the latter case, a much longer delay would be excusable. In fact, if the mistake were such that by ordinary vigilance, it would not be apparent, and the owner of the patent is not put upon notice of its defect, it would seem that the Patent Office could not refuse a reissue even after a delay of several years.

But when the mistake is discovered, the practice requires that its correction be diligently sought, or that failure to act promptly be satisfactorily explained.